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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN C. BARNES, RODNEY W. SCHMIDT, and
GEOFFREY S. STRONGIN

Appeal 2008-006005
Application 10/005,248
Technology Center 2400

Decided: May 7, 2010

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-24; the Appellants appealed therefrom; and we affirmed. The Appellants now request rehearing and ask us to reverse the rejection of claims 1-3, 7-11, 15-19, 23, and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,949,238

("Kamiya") and the rejection of claims 4-6, 12-14, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Kamiya and U.S. Patent No.4,962,533 ("Krueger").

ISSUE

The Appellants make the following new argument.

Claim 1 calls for requesting to execute the instruction and executing the requested instruction. In other words, the instruction called for in claim 1 is the same throughout claim 1 by virtue of its antecedent basis. The instruction in the "requesting" claim element is the same as the instruction in the "executing" claim element. The Examiner has argued *that two different instructions* described in *Kamiya* correspond to the instruction recited in claim 1 (i.e., the Examiner asserts that branch instruction AND the succeeding microinstruction both correspond to the instruction of claim 1).

(Req. Reh'g 3.) Therefore, the issue before us is whether the Appellants have shown that we should consider their new argument.

FINDINGS OF FACT

1. The Examiner made the following findings:

Kamiya discloses a method, comprising

....

- Requesting to execute at least one of the plurality of instructions of set of instructions by a software code running on the processor; [Column 5, lines 23-25) (branch instruction executed)

....

- Executing the requested instruction or set of instructions [column 2, lines 22-24, "the succeeding microinstruction is normally selected"]

(Ans. 9.)

2. The Appellants alleged that "*Kamiya* is completely silent with regard to requesting to execute at least one instruction by the software code running on the processor and executing the requested instruction."

(Amended App. Br. 19.)

3. They further alleged that "*Kamiya* fails to disclose of [sic] make obvious requesting to execute at least one instruction by the software code running on the processor and executing the requested instruction." (Reply Br. 4.)

ANALYSIS

"The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks - the so [-]called 'prima facie case.'" *Ex parte Frye*, No. 2009-006013, 2010 WL 889747, at *3 (BPAI Feb. 26, 2010) (precedential). "On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." *In re Kahn*, 441 F.3d 977, 985-86 (Fed.Cir. 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed.Cir. 1998)). "[T]he Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on

that issue." *Frye*, 2010 WL 889747 at *4. "Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue - or, more broadly, on a particular rejection - the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection." *Id.* (internal citations omitted). "It is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991). Similarly, it is not the function of this Board to examine claims in greater detail than argued by an appellant, looking for distinctions over the prior art.

Here, the Examiner made specific finding about where Kamiya discloses the limitations of claim 1, mapping the exact limitations to specific parts of the reference and explaining the anticipation thereof. (FF 1.) In their Amended Appeal Brief, the Appellants summarily alleged that Kamiya did not disclose a paraphrased part of the claim and underlined parts of the paraphrase. (FF 2.) They did not address, let alone show error in, the Examiner's specific findings. Their Reply Brief was more general, omitting the underlining. (FF 3.)

We reviewed the particular findings contested by the Appellant anew in light of the Appellants' allegations. We refused, however, to examine claim 1 in greater detail than argued by the Appellants, looking for distinctions over the prior art. More persuaded of the Examiner's position than of the Appellants', we affirmed the rejection.

A "request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). Here, the Appellants now argue, for the first time, that the instruction called for in claim 1 is the same throughout claim 1 by virtue of its antecedent basis and that the Examiner has found that two different instructions from Kamiya teach the single instruction recited in claim 1. (Req. Reh'g 3.) The argument was neither overlooked nor misapprehended, however; it was omitted on appeal.

"A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration." *Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed. Cir. 1998) (citing *Moller v. Harding*, 214 USPQ 730, 731 (BPAI 1982), *aff'd*, 714 F.2d 160 (Fed. Cir. 1983) (table)). "Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section." 37 C.F.R. § 41.52(a)(1). *See, e.g., Ex parte Hindersinn*, 177 USPQ 78, 80 (Bd. App. 1971) (An argument advanced in a petition for reconsideration but not advanced in the principal brief or the reply brief was not properly before us); *cf. Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) (citing cases supporting the proposition that issues not raised before the court are not addressed on rehearing).

Here, the Appellants' argument was raised in neither the Amended Appeal Brief nor the Reply Brief. Consequently, the Examiner has had no chance to respond to it. Furthermore, the Appellants identify no recent, relevant decision of the Board or a Federal Court or a new ground of rejection made pursuant to § 41.50(b) to justify their new argument under 37 C.F.R. § 41.52(a)(2) or §41.52(a)(3). Therefore, advancing the argument in the request for rehearing is impermissible

"Any bases for asserting error, whether factual or legal, that are not raised in the principal brief are waived." *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (internal citation omitted) (informative). Here, the Appellants could have made the argument in their Appeal Brief. Because it was omitted therefrom, this basis for asserting error is waived, and the new argument is not properly before us.

CONCLUSION

Based on the finding of fact and analysis above, we conclude that the Appellants have not shown that we should consider their new argument.

DECISION

We deny the Appellants request to reverse the rejection of claims 1-3, 7-11, 15-19, 23, and 24 under § 102(b) as being anticipated by Kamiya and the rejection of claims 4-6, 12-14, and 20-22 under § 103(a) as being unpatentable over Kamiya and Krueger.

Appeal 2008-006005
Application 10/005,248

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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